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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,185	07/30/2003	Chi-Lo Chang	PUSA030752	7090
36672	7590	01/19/2005	EXAMINER	
CHARLES E. BAXLEY, ESQ. 90 JOHN STREET THIRD FLOOR NEW YORK, NY 10038			SELF, SHELLEY M	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/634,185		CHANG, CHI-LO	
	Examiner		Art Unit	
	Shelley Self		3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10, 11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) 8, 9 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 10, 11 and 13 is/are rejected.
- 7) ☒ Claim(s) 3 and 5-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 8, 9 and 12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 19, 2004.

Applicant's election with traverse of the species of Figures 6-9 in the reply filed on November 19, 2004 is acknowledged. The traversal is on the ground(s) that the Examiner has failed to indicate a reason for restriction. This however, is not found persuasive because the species of Figures 6-9 (clms. 8, 9, & 12) are structurally different (i.e. spring construction vs. spring/bolt construction vs. piston/cylinder), accordingly several distinct embodiments are claimed and restriction between the embodiments is required. Also, Applicant has failed to provide a statement that the species are obvious variants of each other as required by the election requirement.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 2 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 2, it is unclear which elements/surfaces "the

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horizontal face” and “the vertical face” are referring to, (i.e. the horizontal or vertical face of the support base, bar, guide or working device). Clarification is required.

Regarding claim 11, no slide box has been positively recited. Therefore a clear understanding of the claims as it relates to the structural relationships between the slide box and the rest of the positively recited elements cannot be obtained. It appears as though claim 11 should be dependent upon claim 5, as claim 5 provides proper antecedent basis for “*the slide box*”. Correction is required.

Additionally, the claims fail to provide proper antecedent bases for the following terms:

“the horizontal face” (clm. 2)

“the vertical face” (clm. 2)

“the slide box” (clm. 11, line 3)

All of the claims should be reviewed for clarity, positively recitation of structural interrelationships and antecedent basis concerns.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 10 as best as can be understood are rejected under 35 U.S.C. 103(a) as being unpatentable over H.J. Eck (2,586,798) in view of Skolink (1,698,827). Eck discloses a semi-automatic mortising machine comprising: a support base (6) including side walls (fig. 1)

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arranged in the X-axis direction, and at least one platform (10, 12) mounted between the two side walls for placing at least one work piece (17); a support bar (9) mounted on the support base in parallel with the X-axis direction and having at least one side face (20) formed with a plurality of tenons (col. 4, lines 66-70); a guide device (13) mounted between the platform (10,12) of the support base (6) and the support bar (9) and operated in a manual manner to displace in parallel according to the profile of the tenons of the support bar (col. 4, lines 17-21; Examiner notes the guide device affixed to the platform 10 and that adjustment of the platform 10 results in displacement of the guide device 13); and a working device having a blade capable of vertical or horizontal placement (i.e. perpendicular or parallel to the board being subjected to tenon/mortise cutting; figs. 7-9). Eck does not disclose the working device blade to be extended downward. It would have been obvious at the time of the invention to one having ordinary skill in the art to rearrange Eck such that the blade extends downwardly, since rearranging parts of an invention involves only routine skill in the art and does not in itself impart patentability. See *In re Japikse*, 86 USPQ 70.

Moreover, Skolink teaches in a similar art the use of a working device having a blade extending downward so as to vertically cut joints (tenon/mortise) into a board (fig. 1). Skolink teaches this construction for efficient cutting of tenon/mortise joints, so that debris from the mortising operation can fall naturally out of the path of the cutting operation. Because the references are from a similar art, it would have been obvious at the time of the invention to one having ordinary level of skill in the art to replace Eck's upwardly extending blade with a downward extending blade so as to efficiently cut joints in a board as taught by Skolink.

With regard to claim 2, as best as can be understood, Eck discloses two platforms (10, 12; Fig. 1).

With regard to claim 10, as best as can be understood, Eck discloses a motor (M1, M2).

Claim 4 as best as can be understood is rejected under 35 U.S.C. 103(a) as being unpatentable over H.J. Eck (2,586,798) in view of Skolink (1,698,827) as applied to claim 1 above, and further in view McCord, Jr. (3,834,435). Neither Eck nor Skolink teach a support bar with a plurality of side faces each formed with a plurality of tenons, which are spaced with a different distance on different side faces. McCord teaches in a closely related art the use of template/supporting bar (fig. 9) having adjacent side faces formed with a plurality of tenons spaced with a different distance on different side faces. McCord teaches this construction for improved versatility in machining tenons/mortises of different size. Because the references are from a closely related art, it would have been obvious at the time of the invention to one having ordinary skill in the art to replace Eck's multi-sided bar having tenons on only one side with a multi-sided bar having tenons on adjacent sides for improved versatility in machining various tenons/mortises as taught by McCord.

Allowable Subject Matter

Claims 3, 5-7 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if any 35 U.S.C. 112 rejections were overcome.

The following is an Examiner's statement of reasons for allowance: The prior art fails to disclose or suggest the following: a positioning member including two rotation disks rotatably

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mounted, between the sidewalls of the support base, two radial displacement rods each extended through the slide seat or a dust collection box as set forth in claims 3, 5 and 13.

The prior art reference, Eck discloses a mortising machine for cutting a plurality of joints (tenons/mortises) with a blade positioned either vertically or horizontally with respect to the work piece and powered by a motor. The mortising machine having a work piece platform, blade guide device and work piece positioning means. Further Eck discloses displacement rods (20) and a slide seat (25, 26) slidably mounted. Eck however, is silent to any rotation disks as a positioning member as set forth in claim 3. Eck is also silent to any dust/debris collection and fails to show any radial displacement rods extending through the slide seat.

This reference, by itself or a combination with the other prior art of record does not disclose or fairly suggest the claimed invention as set forth in claims 3, 5 and 13. Accordingly claims 3, 5 and 13 contain allowable subject matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Allen Shoap can be reached at (571) 272-4514. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIE or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf

January 12, 2004


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